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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Examiner : Robert M. Fetsuga  
Art Unit : 3751  
Applicant : William D. Scott  
Serial No. : 10/694,073  
Filing Date : October 27, 2003  
Attorney Docket No. : 030487.084216-001  
For : HOT TUB COVER

MS APPEAL BRIEF-PATENTS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

APPEAL BRIEF

Applicant appeals from the final rejection of claims 1-2 and 4-9.

I. Real Party In Interest

The real party in interest is the sole inventor and applicant, William D. Scott.

II. Related Appeals and Interferences

There are no related appeals, interferences, or judicial proceedings which may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

Claims 1-2 and 4-9 are pending, finally rejected, and being appealed. Claim 3 is canceled.

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IV. Status of Amendments

No amendments have been filed subsequent to the final rejection.

V. Summary of Claimed Subject Matter

A. Background

A conventional hot tub cover typically includes a core and a jacket, and covers an entire hot tub. The cover typically is fabricated of two halves that can be folded together to aid in removing the cover. The core typically is an expanded polystyrene (EPS), such as that sold under the STYROFOAM trademark. The jacket typically is vinyl.

Conventional hot tub covers with their EPS cores have several disadvantages. First, the cover can become filled with water by a leak in the jacket. When this happens, the EPS core can become waterlogged, leading to interior bacterial growth and/or weakening of the foam. Second, the EPS core supports limited weight, especially if the core has become weakened, and can break for example if and when children play on the cover. Third, the EPS core tends to sag over time, especially if waterlogged, which can allow standing water on the upper surface of the cover permitting undesirable bacterial growth.

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B. The Claimed Subject Matter

As defined in independent claims 1 and 6, the present invention is directed to a long lasting, structural, non-water absorbent cover 12 for a hot tub 10 that overcomes the problems associated with EPS cores. Page 2, lines 6-8. The cover 12 includes a structural, non-water absorbing, plastic core 16 and a water resistant jacket 14 enclosing the core. Page 2, line 3 and Page 3, lines 13-14. A portion (e.g. a half or perhaps a smaller share) of the core 16 is a single piece of plastic that includes upper and lower walls 30, 32 spaced from one another and a plurality of spaced ribs 18 extending between the upper and lower walls 30, 32. Page 4, lines 1-2 and 9-10.

As further defined in independent claim 1, the spaced ribs 18 define a plurality of openings or spaces 40 therebetween. Page 4, lines 18-19.

As further defined in independent claim 6, the upper wall 30 slopes downwardly from a central portion to an outer edge 28. Page 2, lines 4-5. Also, the claim 6 core is defined as “polymeric” rather than “structural, non-water absorbing, plastic” (as in claim 1).

VI. Grounds of Rejection to be Reviewed on Appeal

Whether independent claims 1 and 6 are patentable under 35 U.S.C. § 103(a) over U.S. Patent No. 5,086,525 to Christopher in view of U.S. Patent No. 3,274,315 to Kawamura. All of the claims form a single group, and consequently dependent claims 2, 4-5, and 7-9 do not need to be separately considered.

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## VII. Argument

### A. Applied References

Christopher is typical of the prior art hot tub covers described in the Background of the Invention. Specifically, the Christopher cover includes a polystyrene insert 40 enclosed within a vinyl jacket. As such, Christopher suffers the precise problems that the present invention overcomes. The polystyrene core can absorb water over time, weakening the foam and causing the cover to sag. Safety issues can result, for instance when children play on a hot tub cover that has a deteriorated or waterlogged core, due to the increased risk of falling through the cover.

Kawamura discloses resin articles with various cross sections having hollow spaces. For example, one configuration includes independent air cells for elasticity, and another includes partitions or isthmuses for strength. Col. 7, lines 3-7. The synthetic resin articles provide sound-absorbing, damp-proofing, shock-absorbing, and adiabatic properties. Col. 7, lines 9-12. Exemplary applications for the synthetic resin articles include “packing, insulation, construction material, decorations and other applications.” Col. 7 lines 9-10. Kawamura has nothing to do with hot tub covers.

Edgar is applied only in the rejection of claims 4 and 8. Because those claims are grouped with their respective independent claims, Edgar is not relevant to this appeal.

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B. Claims 1-2 and 4-9

Applicant submits that the Examiner has not presented a *prima facie* case of obviousness, because there is no suggestion in the references or in the art for combining Christopher and Kawamura. Obviousness cannot be established by combining the teachings of the prior art, *absent some teaching, suggestion, or incentive supporting the combination*. ACS Hospital Systems, Inc. v. Montefiore Hospital 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis added). The mere fact that the references can be combined or modified does not render the resultant combination obvious, unless the prior art also suggests the desirability of the combination. In re Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000); In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990).

Christopher does not teach or suggest a core wherein a portion of the core is a single piece of plastic including upper and lower walls spaced from one another and a plurality of spaced ribs extending therebetween. The Examiner notes that “Christopher teaches all claimed elements except for” this novel structure. However, this novel structure is the very heart of the present invention. In other words, Christopher is nothing more than the prior art acknowledged in the Background of the Invention, which suffers a variety of noted problems.

Neither reference recognizes -- let alone addresses -- the problem solved by the present invention. Nothing, other than impermissible hindsight, suggests that the synthetic resin article of Kawamura could be substituted into a hot tub cover for the polystyrene core of Christopher in an attempt to address the problems solved by the present invention. In fact, the

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additional elasticity disclosed in Kawamura teaches away from the present invention because elasticity is not desired in a hot tub cover.

Kawamura has nothing to do with hot tub covers, and is from a field totally unrelated to that of hot tub covers. Kawamura does not teach or suggest fabricating a hot tub cover -- or indeed any covered article -- by enclosing one of the disclosed resin boards within a water resistant jacket. The synthetic resin article disclosed by Kawamura is from a nonanalogous art, such that a person of skill in the claimed art would not look to that nonanalogous art to address the problem solved by the claimed invention. Section 103 requires a presumption that the inventor has full knowledge of the prior art *in the field of his endeavor*, but it does not require a presumption of full knowledge by the inventor of prior art *outside the field of his endeavor, i.e. of "nonanalogous" art*. In re Winslow, 151 USPQ 48 (C.C.P.A. 1966). Applicant submits that no person skilled in the art of designing and/or fabricating hot tub covers would look to the art of packaging or insulation for a solution to the problem addressed by the present invention.

In summary, Kawamura does not relate to the field of the present. Further, neither of the applied reference recognizes or contemplates the problem solved by the present invention. Even further, neither of the applied references -- or the claimed art in general -- provides any motivation or incentive for the attempted hindsight reconstruction of the claimed subject matter. Therefore, the rejection of the independent claims is improper and should be reversed.

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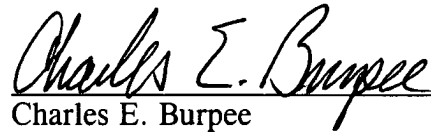
VIII. Conclusion

In conclusion, the Examiner's rejection under 35 U.S.C. 103(a) based on an impermissible hindsight combination of references is improper and should be reversed.

Respectfully submitted,

WILLIAM D. SCOTT

By: Warner Norcross & Judd LLP

A handwritten signature in cursive script, reading "Charles E. Burpee", is written over a horizontal line.

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#### VIII. Claims Appendix

The claims involved in the appeal are:

1. (Previously presented) A cover for a hot tub or spa, comprising:  
  
a structural, non-water absorbing, plastic core, a portion of said core being a single piece of plastic, said portion including upper and lower walls spaced from one another and a plurality of spaced ribs extending between said upper and lower walls, said spaced ribs defining a plurality of openings therebetween; and  
  
a water resistant jacket enclosing said core.
2. (Previously presented) The cover of claim 1 wherein said core includes:  
  
two core halves, each half being a single unitary piece; and  
  
a hinge hingedly interconnecting said halves, whereby said cover can be folded in half for removal and installation.
3. (Canceled)
4. (Previously presented) The cover of claim 1 further comprising an insulated foam within said openings.
5. (Previously presented) The cover of claim 2 wherein each half includes a hinged edge and a peripheral edge, said upper wall sloping downwardly from said hinged edge to said peripheral edge.
6. (Previously presented) A cover for a hot tub or a spa, comprising:  
  
a polymeric core, a portion of said core being a single unitary piece, said portion including an upper wall and a lower wall, said upper wall having a central portion and an outer



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edge, said upper wall sloping downwardly from said central portion to said outer edge, said core further including a plurality of ribs extending between said upper and lower walls; and  
a water resistant jacket enclosing said core.

7. (Original) The cover of claim 6 wherein said cover is hinged in said central portion, whereby said cover can be folded approximately in half.

8. (Original) The cover of claim 7 further comprising an insulating material between said ribs.

9. (Previously presented) The cover of claim 1 wherein said openings are filled with air.

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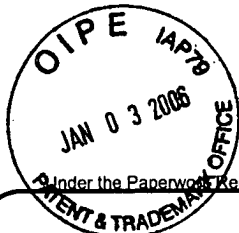
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IX. Evidence Appendix

There is no evidence submitted pursuant to Sections 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner.

XI. Related Proceedings Appendix

There are no decisions rendered by a court or the Board in any proceeding identified pursuant to 37 C.F.R. §41.37(c)(1)(ii).



PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

12

Application Number

10/694,073

Filing Date

10/27/2003

First Named Inventor

William D. Scott

Art Unit

3751

Examiner Name

Robert M. Fetsuga

Attorney Docket Number

030487.084216-001

**ENCLOSURES (Check all that apply)**

<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input checked="" type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences*
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Reply to Missing Parts/Incomplete Application	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<b>Remarks</b> *Appeal Brief (10 pp)	

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	Warner Norcross & Judd LLP		
Signature	<i>Charles E. Burpee</i>		
Printed name	Charles E. Burpee		
Date	12/28/2005	Reg. No.	29,776

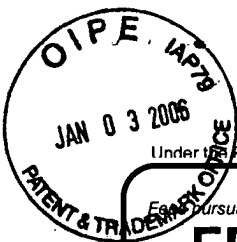
**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature	<i>Charles E. Burpee</i>		
Typed or printed name	Charles E. Burpee	Date	12/28/2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Effective on 12/08/2004.

Enacted pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

**FEE TRANSMITTAL**  
**For FY 2005**☒ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 250.00**Complete if Known**

Application Number	10/694,073
Filing Date	10/27/2003
First Named Inventor	William D. Scott
Examiner Name	Robert M. Fetsuga
Art Unit	3751
Attorney Docket No.	030487.084216-001

**METHOD OF PAYMENT** (check all that apply)☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_☒ Deposit Account Deposit Account Number: 23 0457 Deposit Account Name: Warner Norcross & Judd LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17☒ Credit any overpayments**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES****Fee Description**

Each claim over 20 (including Reissues)

Fee (\$)	Small Entity Fee (\$)
50	25

Each independent claim over 3 (including Reissues)

200	100
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Multiple dependent claims

360	180
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Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 20 or HP = _____ x _____ = _____			

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 3 or HP = _____ x _____ = _____			

HP = highest number of independent claims paid for, if greater than 3.

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____				

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

**Fees Paid (\$)**Other (e.g., late filing surcharge): Appeal Brief

250.00

**SUBMITTED BY**

Signature

Charles E. BurpeeRegistration No.  
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Name (Print/Type)

Charles E. Burpee

Date 12/28/2005

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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